

U.S.S.N. 10/709,206

-2-

GSTS 0102 PA

IN THE DRAWINGS:

Please substitute the one (1) sheet of drawing submitted herewith containing Figure 4 in place of the originally-filed drawing sheet containing the same Figure.

U.S.S.N. 10/709,206

-11-

GSTS 0102 PA

REMARKS

Claims 12-34 are currently pending in the above-entitled application. Claims 1-11 have been withdrawn from consideration.

Applicant notes the Examiner's Remarks regarding the Information Disclosure Statement. Applicant will include any references included in the specification and not previously included in an Information Disclosure Statement on a Supplemental Information Disclosure Statement submitted in conjunction herewith.

The drawings stand objected to for failure to comply with 37 CFR 1.84(p)(5) as not including reference numerals 66A and 66B included in the specification. Applicant thanks the Examiner for pointing out this oversight and has added reference numerals 66A and 66B to Figure 4. Reconsideration of the drawings is respectfully requested.

Claims 24 and 26 stand objected to for informalities listed in paragraph 4 of the Office Action. Applicant notes these objections, and have made corrections as suggested by the Examiner to correct these informalities. Reconsideration of claims 24 and 26 is respectfully requested.

Claims 15, 17, 25-28, 32 and 33 stand rejected under 35 USC 112, second paragraph, as being indefinite for reasons stated in paragraphs 6-15 of the Office Action. Applicant respectfully traverses the Examiner's rejections. However, in an effort to move this case towards allowance, Applicant has first cancelled claims 15 and 17 without prejudice. Moreover, Applicant has amended claim 12 to incorporate a portion of the claim 13 including a plurality of pallets and modified claim 26 to address the antecedent basis problem with respect to "said pallets" in claims 25 and 26. Further, Applicant has modified claim 26 to correct the antecedent basis problem with respect to "the modular playing field." Additionally, Applicant has amended claims 27, 28, 32 and

U.S.S.N. 10/709,206

-12-

GSTS 0102 PA

33 to read "said layer of resilient particle infill", as is disclosed in claim 12. Reconsideration of claims 15, 17, 25-28, 32 and 33 is thus respectfully requested.

Claims 12, 15, 18, 19, 21-23 and 29 stand rejected as being unpatentable over Palmer et al. (U.S. Patent No. 3,735,988) in view of Lemieux (U.S. Patent No. 6,740,387). Applicant respectfully traverses the Examiner's rejection.

In stating his rejection in Paragraph 17 of the Office Action, the Examiner first describes a pair of reference numerals that are inconsistent with, or inaccurate with, what is described in the specification of Palmer. Specifically, the Examiner refers to modular base structure 136 and elastomeric material 113 on pages 5 and 6 of the Office Action. Conversely, the specification refers to rubber anti-skid mat 136 and base portion 113. Applicant is therefore unclear as to how to respond to the Examiner's rejection in lieu of these inaccuracies. Applicant respectfully requests clarification with regards to this rejection.

Applicant has herein modified claim 12 to include a portion of the subject matter of dependent claim 13, wherein each of said plurality of modular units comprises a modular base structure comprising a plurality of pallets fastened together. Applicant notes that Palmer or Lemieux, alone or in combination, discloses a modular base structure comprising a plurality of pallets fastened together. Applicant has also modified claims 12 and 29 to positively include the removable plastic sleeve and infill to the modular unit. Applicant notes that neither Palmer nor Lemieux disclose a removable plastic sleeve coupled around the modular base structure. In accordance with MPEP 2143, therefore, the Examiner has not established a *prima facie* case of obviousness, and thus the rejection must be overturned. Reconsideration of claims 12, 15, 18, 19, 21-23 and 29 is thus respectfully suggested.

Claims 12, 14, 15, 17, 18, 21, 22, 29 and 34 stand rejected as being unpatentable over Prevost. (U.S. Application No. 2004/0058096) in view of Starp (U.S. Patent No. 5,082,712).

U.S.S.N. 10/709,206

-13-

GSTS 0102 PA

For reasons stated above, the Applicant notes that Prevost or Starp, alone or in combination, discloses a modular base structure comprising a plurality of pallets fastened together. Moreover, neither Prevost nor Starp, alone or in combination, describes a removable plastic sleeve coupled around each of the modular base structures. Moreover, with respect to claim 12, neither Prevost nor Starp, alone or in combination, disclose that the plastic sleeve that is removed prior to abutting a pair of the modular base structures together. In accordance with MPEP 2143, therefore, the Examiner has not established a *prima facie* case of obviousness, and thus the rejection must be overturned. Reconsideration of claims 12, 14, 15, 17, 18, 21, 22, 29 and 34 is thus respectfully suggested.

Claims 12-15, 17, 18, 21, 22, 29 and 34 stand rejected as being unpatentable over Prevost. (U.S. Application No. 2004/0058096) in view of Ripley (U.S. Patent No. 5,595,021). Applicant respectfully traverses the Examiner's rejection.

Section 2143 of the Manual of Patent Examining Procedure states that three basic criteria must be met for establishing a *prima facie* case of obviousness, stating:

"First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations."

"If the examiner does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Section 2142 MPEP, ch. 2100, p. 110. "When the references cited by the Examiner fail to establish a *prima facie* case of

U.S.S.N. 10/709,206

-14-

GSTS 0102 PA

obviousness, the rejection is improper and will be overturned."¹ One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.² Applicant respectfully submits that the Examiner has failed to establish any of the basic criteria, much less all of the three criteria, for establishing a *prima facie* case of obviousness, and thus the rejection is improper and must be overturned.

First, Applicant submits that the combination of Ripley and Prevost does not teach all of the limitations of claim 12, the third of the three basic criteria described above required to establish a *prima facie* case of obviousness.

As stated in Column 4, Ripley discloses the turf unit 20 is natural grass that is grown in a growing pan 28 having sidewalls 32. The turf unit also includes a fence 30 connected to the top ledge 34 of the growing pan 28 maintained at a height above the sidewalls 32. When formed in a geographic configuration, as shown in Figure 13, the fence 30 of the growing pans 28 is lowered and the individual growing pans 28 are first placed onto locator pads 62 having cone locaters 64 and are subsequently coupled together using fastening means 60.

The Examiner believes, beginning in the first full paragraph of page 12 of the Office Action, that the structure described in the preceding paragraph is "a modular base structure comprising a plurality of pallets (20) fastened together via fastening means (60) in a rectangular fashion (fig. 13) and placing at least two of the plurality of modular base structures on a relatively flat surface in a desired configuration." However, reference numeral 20 in Ripley discloses a turf unit, not a pallet, contrary to the Examiner's determination. Moreover, the growing pan disclosed in Ripley is not the equivalent of a pallet. As neither Ripley nor Prevost discloses a pallet, the third of the three basic criteria is not met for this reason alone.

¹ In re Ochiai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), *citing* In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

² In re Fine, 837 F.2d at 1075.

U.S.S.N. 10/709,206

-15-

GSTS 0102 PA

Moreover, Examiner additionally believes that Ripley discloses "a plurality of modular base structures." The Examiner gleans support for these statements from Column 3, line 65 –column 6, line 66 and figures 1-3, 13, and 14 of the specification. However, the modular base structures of claim 12 comprise a plurality of pallets, which Ripley does not disclose. As neither Ripley nor Prevost discloses a modular base unit consisting of a plurality of pallets fastened together, the third of the three basic criteria is not met for this additional reason.

In addition, the changes made to claims 12 and 29 to positively cite a removable sleeve as a portion of the modular base unit are not disclosed in either Ripley or Prevost. As such, for this additional reason, claims 12 and 29 are not taught by the combination of Ripley and Prevost.

Further, the Examiner has failed to show any motivation or suggestion for making the proposed design change to either Prevost or Ripley to arrive at the present invention as in claims 12 and 29. Prevost is itself directed to a modular synthetic turf assembly, so there is no motivation to alter the design of its system to include the modular base system comprising a plurality of pallets. In addition, there is no motivation to modify Ripley, which is directed to a natural grass surface, and has growing trays and structure designed specifically to maintain and align the natural grass. For these reasons, the Examiner has failed to prove that there is motivation to combine Prevost and Ripley, contrary to the Examiner's determination.

In addition, the Examiner has failed to prove the second criteria for establishing a *prima facie* case of obviousness, namely that there is a reasonable expectation of success to modify the references as the Examiner proposes. The Examiner proposes combining the turf unit assembly of Ripley with the underlying turf structure in Prevost to arrive at the present invention. However, in addition to the limitation missing as described above, it is unclear how the Examiner proposes modifying Prevost, or Ripley to arrive at what is described in claim 12, and as such, there is no reasonable

U.S.S.N. 10/709,206

-16-

GSTS 0102 PA

expectation of success as required by MPEP 2143. To wit, to arrive at the invention claimed in claim 12, Ripley's turf would have to be removed and replaced with a synthetic grass surface. In addition, the design of the growing trays would have to be modified to remove the baffles, flatten the upper surface to receive an elastomeric layer and turf, and include openings on the sides to attempt to mimic the pallet structure. In addition, fence would have to be removed, and the gaps 36 in the sidewalls removed. In essence, what the Examiner proposes is classic hindsight reconstruction, which is inappropriate for establishing a *prima facie* case of obviousness. The Examiner has thus failed to prove the combining the references would be successful.

For all of these reasons, the Ripley and Prevost does not establish any of the three basic criteria necessary for establishing a *prima facie* case of obviousness as required by MPEP 2143. As such, claims 12 and 29, and dependent claims 13-34 therefrom, are not obviated by the combination of Prevost and Ripley. Reconsideration of claims 12-34 is thus respectfully requested.

Claims 16, 27, 28, 32 and 33 stand rejected as being unpatentable over Prevost. (U.S. Application No. 2004/0058096) in view of Starp (U.S. Patent No. 5,082,712) or Prevost (U.S. Application No. 2004/0058096) in view of Ripley (U.S. Patent No. 5,595,021), as applied to claim 12 above, and further in view of Prevost (U.S. Patent Application No. 2002/136846). Claims 19 and 20 stand rejected as being unpatentable over Prevost. (U.S. Application No. 2004/0058096) in view of Starp (U.S. Patent No. 5,082,712) or Prevost (U.S. Application No. 2004/0058096) in view of Ripley (U.S. Patent No. 5,595,021), as applied to claim 12 above, and further in view of Tomarin (U.S. Patent No. 4,637,942). Claims 25 and 26 stand rejected as being unpatentable over Prevost (U.S. Application No. 2004/0058096) in view of Ripley (U.S. Patent No. 5,595,021), as applied to claim 12 above, and further in view of Patterson (U.S. Patent No. 5,309,846). Applicant respectfully traverses the Examiner's rejection for reasons stated in the previous paragraphs above.

U.S.S.N. 10/709,206

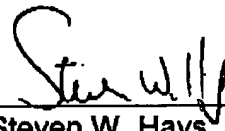
-17-

GSTS 0102 PA

Applicant respectfully suggests that claims 12-34 are in proper form and allowable over the cited prior art. The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 223-9500 if any unresolved matters remain.

Respectfully submitted,

ARTZ & ARTZ, P.C.

By: 
Steven W. Hays
Reg. No. 41,823
28333 Telegraph Road
Suite 250
Southfield, MI 48034
(248) 223-9500

Dated: August 8, 2006